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Robert E. Malm

In re Application of:

GREGORY E. JOHNSTON et al.

Serial Number: 09/059,077

Filing Date: 04/09/98

For: MOBILE SURVEILLANCE SYSTEM

Group Art Unit: 2612

Examiner: LUONG T. NGUYEN

Telephone: (703) 308-9297

PETITION PURSUANT TO 37 CFR 1.182

Commissioner for Patents
Office of the Deputy Commissioner for Patent Examination Policy
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

An appeal brief in support of applicants' appeal to the Board of Patent Appeals and Interferences from the decision dated 01/27/05 of the examiner finally rejecting claims 1-11, 14,

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15, and 17-25 was submitted on March 9, 2005. A revised appeal brief consonant with the requirements of 37 CFR 41.37 was submitted on June 29, 2005. On September 21, 2005 the examiner for the above-referenced patent application mailed an office action which reopened prosecution for the purpose of entering new grounds of rejection of all claims based on a new set of references.

The entering of new grounds of rejection in the examiner's answer to applicants' appeal brief was until recently prohibited by 37 CFR 1.193(a)(2), *Examiner's answer and reply brief*. This prohibition was removed in 2004 by 37 CFR 41.39(a)(2), *Examiner's Answer*. The reason for this revision, according to the Federal Register, was to "improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution." The Federal Register went on to say that reopening prosecution for the purpose of entering a new ground of rejection should only be used under special circumstances: "Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record." No such special circumstances exist in the case of applicants' patent application.

Applicants therefore, pursuant to 37 CFR 1.182, hereby petition the Director to instruct the examiner to maintain applicants' appeal by rescinding his decision to reopen prosecution of applicants' patent application and furnishing a written answer to applicants' appeal brief.

BACKGROUND

Appellants' invention is a mobile surveillance system comprising (1) a pan-and-tilt video camera attached to a mount assembly for capturing mobile images, (2) a display-control box

having an image display screen and control buttons for controlling the camera and its movement, and (3) an image capture box for receiving the captured images.

The application was filed on April 9, 1998 and the first office action was mailed on October 23, 1998. There were 16 references cited, and all claims were rejected based on one or more of the cited references. Appellants provided detailed arguments in the response to the office action for each of the rejected claims as to why none of the references, either separately or in combination, disclosed the limitations of the claim.

The second office action was mailed on April 14, 1999. The examiner stated that appellants' arguments in response to the first office action were moot in view of new grounds of rejection brought about "because claim 1 in the first action was so unclear, the examiner did not realize an important limitation was neglected." The "new grounds of rejection" were the result of the examiner presumably doing another search and adding two additional references, not included in the original 16, which the examiner believed would remedy the problem of the "neglected limitation" of claim 1. Once again, all of the claims were rejected. And once again, appellants provided detailed arguments in the response to the office action for each of the rejected claims as to why none of the references, either separately or in combination, disclose the limitations of the claims.

The third and final office action was prepared by a new examiner who continued the tradition of rejecting all of the claims.

Since the examiners could find nothing patentable in appellants' invention and believing very strongly that there was nothing in the prior art discovered by the examiners which disclosed appellants' invention, appellants appealed to the Board of Patent Appeals and Interferences.

The Conclusion of the Decision on Appeal was brief: "The decision of the examiner rejecting claims 1 through 25 under 35 U.S.C. § 103 is reversed." Appellants then received an office action dated July 4, 2004 once again rejecting all 25 claims. The introductory sentence of the office action stated:

"In view of the decision of the Board of Patent Appeals and Interferences rendered on 12/10/2003, PROSECUTION IS HEREBY REOPENED. A non-final Office Action set forth below [*sic*]."

And the text of the Office Action then continued for 13 pages again rejecting all of the claims based on a "newly-discovered" 1983 reference.

Appellants were surprised by the reopening of prosecution in view of the passage from the Manual of Patent Examining Procedure (MPEP) § 1214.07, "Reopening of Prosecution", which cited 37 CFR 1.198:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown."

Section 1.114 has to do with the filing by the appellants of a request for continued examination which appellants did not do. Section 1.196 has to do with aspects of the Board's decision (e.g. new grounds of rejection, specific statement that a claim may be allowed in amended form, remand), none of which arose in the present situation.

What, then, would constitute "matters not already adjudicated" that would allow the reopening of prosecution and was sufficient cause shown?

A passage from the Manual of Patent Examining Procedure (§ 1214.04, "Examiner Reversed") states that:

"If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection."

The term "prosecution" encompasses the entire patenting process. For example, "prosecution history" (according to Black's Law Dictionary) means the complete record of proceedings in the Patent and Trademark Office from the initial application to the issued patent.

"Prosecution" entails "examination" which requires an examiner to "make a thorough investigation of the available prior art relating to the subject matter of the claimed invention." 37 CFR 1.104(a)(1). Thus, a reopened prosecution means a reexamination which includes a new search. Thus, when 37 CFR 1.198 states that cases may be reopened only with sufficient cause being shown, it does not mean that the examiner may informally reopen prosecution to perform a new search and if the results of the new search provide sufficient cause, request the Technology Center Director to formally reopen prosecution for the purpose of entering the new rejection.

Once a new search has been initiated, it is certain that an examiner will be able to find a reference on the basis of which he or she can argue the unpatentability of an invention. An example is the 04/07/04 Office Action where the examiner continued to argue incorrectly the unpatentability of all of appellants' claims after three searches and for three sets of references.

The key reference which provided the basis for rejecting all of appellants' claims in the 04/07/04 Office Action was Clendenin et al., U.S. Patent 4,386,848 issued on June 7, 1983, some

22 years ago. If the examiner had "specific knowledge of the existence" of this reference, it would seem unlikely that this knowledge was recently acquired, since the patent is so old. And if the examiner in some way became aware of it at an earlier time, why was it not brought forth during the original prosecution of appellants' application?

Appellants' responded to the examiner's 04/07/04 Office Action, based on Clendenin et al., with detailed arguments as to why the "newly-discovered" Clendenin et al. reference, either by itself or in combination with other previously-discovered references, did not disclose appellants' invention.

The examiner responded with a 23-page Office Action dated 01/27/05 which stated that "Applicant's arguments . . . have been fully considered but they are not persuasive" except, apparently for claims 12, 13, and 16 which the examiner conceded would be patentable if rewritten in independent form.

Appellants then appealed to the Board of Patent Appeals and Interferences and filed an appeal brief based on the same arguments which the examiner had previously "fully considered" and found "not persuasive". However, in rereading appellants' arguments in the Appeal Brief, the examiner appears to have had a change of heart and concluded that Clendenin et al. was not the magic bullet that he thought it was. The introductory sentence of his 09/21/05 Office Action stated:

"In view of the Appeal Brief filed on 7/01/2005, PROSECUTION IS HEREBY REOPENED. A non-final Office Action set forth below [*sic*]."

And the text of the Office Action then continued for 12 pages again rejecting all 25 claims based on a presumably "newly-discovered" Japanese patent to Maruyama et al.

ISSUES AND ARGUMENTS

Issue I - Whether it is more appropriate in view of 37 CFR § 41.39 for the examiner to include a new ground of rejection in his answer to appellants' appeal brief.

The examiner's statement that "in view of the Appeal Brief filed on 7/01/2005, prosecution is hereby reopened" appears to be a de facto withdrawal of his claim rejections based on Clendenin et al. and the substitution of new grounds of rejection based on a new reference Maruyama et al.

It would be more in keeping with 37 CFR § 41.39 if the examiner were to entitle his latest office action as his answer to appellants' appeal brief and to unambiguously state that he is withdrawing his previous grounds of rejection based on Clendenin et al. and including new grounds of rejection based on Maruyama et al. Whereas this action by the examiner would have been prohibited under prior rule 37 CFR § 1.193(a)(2), it is now permitted under 37 CFR § 41.39(a)(2). The Federal Register explains the reason for allowing examiners to include new grounds of rejection in their answers to appeal briefs as follows (see boldface portion):

Section 41.39 is added to generally incorporate requirements found in former Rule 193(a).

Section 41.39(a)(2) is added to permit a new ground of rejection to be included in an examiner's answer eliminating the former prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board

without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency. 69 FR 49963, Aug. 12, 2004 (highlighting added).

In view of the persuasive language shown in boldface encouraging if not mandating the examiner to include new grounds of rejection in his answer, why would an examiner choose to reopen prosecution in order to make a new ground of rejection? The patent office envisions certain circumstances wherein such an action might be preferred (see boldface portion):

It is envisioned that new grounds of rejection in examiner's answers would be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, e.g., responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence. 69 FR 49963, Aug. 12, 2004 (highlighting added).

But in the present case there are no new argument(s) or new evidence for the examiner to address. Appellants' arguments appearing in the appeal brief are the same as those appearing in appellants' response to the examiner's office action reopening prosecution after the decision on the first appeal, and appellants have not introduced any new evidence. There is simply no legitimate purpose for the examiner to reopen prosecution to enter new grounds of rejection rather than including the new grounds of rejection in his answer to appellants' appeal brief.

Issue II - Whether the examiner is obligated to enter a new ground of rejection by way of his answer to the appeal brief if appellants have not introduced new arguments or evidence by way of the appeal brief.

MPEP § 1207.04 (Reopening of Prosecution After Appeal) falls under the umbrella of 37 CFR § 41.39 and there is a tension between the two in that an examiner has two options for entering a new ground of rejection. He may either reopen prosecution (MPEP § 1207.04) or include the new ground of rejection in his answer to the appeal brief (37 CFR § 41.39(a)(2)). This change in procedure brought about by 37 CFR § 41.39(a)(2) is described in the Federal Register as being a revision that "would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution." 69 FR 49963, Aug. 12, 2004. Including the new ground of rejection in the examiner's answer is clearly the preferred option. Reopening prosecution is an option only under special circumstances as, for example, when "a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record." 69 FR 49963, Aug. 12, 2004.

At this point in time, the MPEP does not reflect the views expressed in the Federal Register:

After an appeal brief under 37 CFR 41.37 has been filed and the examiner has considered the issues on appeal, the examiner may:

(A) reopen prosecution to enter a new ground of rejection with approval from the supervisory patent examiner (see MPEP § 1207.04);

(B) withdraw the final rejection and allow the application if the examiner determines that the rejections have been overcome and no new ground of rejection is appropriate; or

(C) maintain the appeal by conducting an appeal conference (MPEP § 1207.01) and draft an examiner's answer (MPEP § 1207.02).

MPEP § 1207.

Note that the simplest option for the examiner is (A) and all he needs is the approval of an SPE. The most complicated option is (C) and the examiner must in choosing this option (1) conduct an appeal conference and (2) draft an examiner's answer. Which will be the most appealing choice for the examiner?

The foreword of the MPEP states that: "The Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations." The only Rule governing the entry of new grounds of rejection after appeal appears to be 37 CFR 41.39(a)(2) which states that "an examiner's answer may include a new ground of rejection". The Federal Register provides a rationale for this change from prior Rule 37 CFR 1.193(a)(2) by stating that reopening prosecution is an option for entering a new ground of rejection only under special circumstances as, for example, when "a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record."

Unless there were such special circumstances in the case of appellants' appeal, the examiner should be required to follow the precepts of 37 CFR 41.39(a)(2) and enter the new ground of rejection by way of his answer to appellants' appeal brief.

Issue III - Whether there are special circumstance which would prevent the examiner from entering a new ground of rejection by way of his answer to appellants' appeal brief.

Appellants have not introduced new amendments or evidence by way of the appeal brief. There is nothing lacking in the record which would prevent the examiner from entering a new ground of rejection in his answer to appellants' appeal brief.

Appellants have been prosecuting this patent application for almost eight years. All 25 claims (with no substantive amendments since they were filed) have been finally rejected three times on the basis of three different sets of references. The first rejection was followed by an appeal which resulted in a complete reversal of the examiner's rejections. The examiner presumably did another search, again rejected all claims based on a new set of references, and appellants again appealed. The examiner reviewed this second appeal brief (which contained the same arguments presented in appellants' earlier response to the examiner's office action) and concluded that his rejections were incorrect. He presumably did still another search, and again rejected all claims based on a third set of references.

Over this almost eight-year period, the examiners have come up with four sets of references with which to reject appellants' claims, and appellants have appealed once and won and are now in the midst of a second appeal. Three separate and distinct appeal briefs have been prepared.

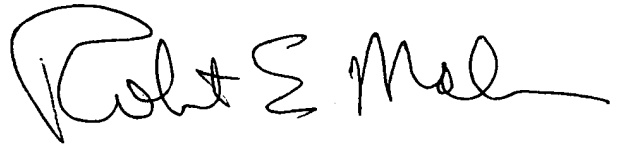
Is it fair and just at this point for the examiner to reopen prosecution and delay the issuance of a patent to appellants for perhaps three or four more years?

* * * * *

A check for the filing fee for a petition under 37 CFR 1.182 as set forth in § 1.17(h) is enclosed.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. 13-1239.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert E. Malm", with a long horizontal flourish extending to the right.

Date: 11/17/05
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